



PATENT  
P56138PCT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#10  
12-4-03

In re Application of:

MYOUNG-JIN KIM

Serial No.: 09/582,843

Examiner: AHMED, SAMIR ANWAR

Filed: 5 July 2000

Art Unit: 2623

For: METHOD FOR INSPECTING INFERIORITY IN SHAPE

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REQUEST FOR CLARIFICATION RECEIVED

Commissioner for Patents  
P.O.Box 1450  
Alexandria, VA 22313-1450

NOV 19 2003

Technology Center 2600

Sir:

Applicants, pursuant to 37 CFR §1.104(a), (b) and (c), and the guidance offered by the United States Court of Appeals for the Federal Circuit in its decision in *In re Sang Su Lee*, 61 USPQ2d 1430 (Fed.Cir. 2001), respectfully requests clarification relative to the Examiner's comments in the Office action mailed on the 18<sup>th</sup> of June 2003, (Paper No. 5), and also request that the period for response be restarted as of the date of mailing of the clarifying communication.

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Date: 11/18/03

I.D.: REB/wc

**REMARKS**

The Office action mailed on the 18<sup>th</sup> of June 2003 ( Paper No. 5) has been carefully considered.

The Examiner has asserted that Longest '392 judges:

“Whether *inferiority in shape of* the inspection *object* exists, based on the result of the grayscale comparison”, Examiner’s Comments, page 3, referring to column 5, lines 57-59 and column 7, lines 29-33.

These passages of Longest '392 are devoid of the phrases “*inferiority in shape*” and “*shape of*” and “*object*”. These phrases are all found in Applicant’s pending claims.

In view of the foregoing noted deficiencies, the Office action is incomplete and fails to comply with the requirements set forth in 37 CFR §1.104(a)-(c). In response, the Examiner’s request to complete the Office action by:

- Identifying “the particular part relied on” in the Office action, of Longest '392, to teach Applicant’s “inspecting inferiority in shape”.
- Identifying “the particular part relied on” in the Office action, of Longest '392 to teach Applicant’s judging of “whether inferiority in shape of the inspection object exists.

In its written decision rendered in the *In re Sang Su Lee* Appeal, the United States Court of Appeals for the Federal Circuit noted that the Applicant,

“Lee has pressed the Examiner during prosecution for some teaching, suggestion, or motivation in the prior art to select and combine the references that were relied on to show obviousness.” *In re Sang Su Lee, ibid.*

Applicant here makes the same request for clarification. Is the Examiner’s reading of this

reference in conformance with the International Search Report?

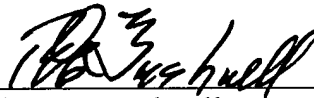
**Conclusion**

It is respectfully requested that a revised Office action be issued so as to state on the record the Examiner's identification of the "particular part relied on "in making the rejection of claims 1 through 3 and 7, and to rectify the various inconsistencies stated above.

It is also requested that the period for response be restarted as of the mailing date of the revised Office action and/or clarifying communication.

No fee is incurred by this Request.

Respectfully submitted,



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